

Atty. Dkt. No. 051373-0115

REMARKS

In this reply is in response to the final office action mailed on January can come in 2006 in which claims 1-21 were rejected. Claims 5 and 6 are amended. Claims 1-21, as amended, are presented for reconsideration and allowance.

I. Examiner Interview Summary

On or about April 6, 2006, a telephonic interview was held between Examiner Blenman and Applicants' attorney, Todd A. Rathe. The rejection of claims 5, 6 and claims 9 and 10 were discussed. Although no agreement was reached, Applicants wish to thank the Examiner for the opportunity to discuss the rejections.

III. Objection to the Disclosure

Paragraph 3 of the Office Action objected to the disclosure noting the presence of an embedded hyperlink. In response, paragraph [0004] is amended. Accordingly, applicants respectfully request that the objection to the disclosure be withdrawn.

III. Rejection of Claims 1-2, 4-8, 11-13 and 15-21 under 35 USC 103(a) Based upon Hara, Haynes and Creswell

Claims 1-2, 4-8, 11-13 and 15-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara et al. ("Hara," U.S. Patent No. 5,938,725) in view of Haynes et al. ("Haynes," U.S. Patent No. 6,442,591) and in further view of Creswell et al. ("Creswell," U.S. Patent No. 6,564,264). Claims 5 and 6 are amended. Claims 1-2, 4-8, 11-13 and 15-21, as amended come overcome the rejection.

A. Claims 1, 12, 16 and 21

Independent claim 1 is directed to a method of populating a contact list on a portable device and recites:

extracting contact information from a number of messages stored in a memory in the portable device; and

Atty. Dkt. No. 051373-0115

entering the extracted contact information into a contact list maintained by a program operating on the portable device.

Independent claim 12 is directed to a user interface in a portable device configured to facilitate the populating of a contact list and recites, among other limitations:

means for extracting contact information from a number of messages stored in a memory in the portable device; . . .

means for entering the selected contact information into a contact list maintained by a program operating on the portable device.

Independent claim 16 is directed to a processing system and recites, among other limitations:

a storage device . . . having stored there information for configuring the CPU to:

extract contact information from a number of messages stored in a memory in the portable device; and

enter the extracted contact information into a contact list maintained by a program operating on the portable device.

Independent claim 21 is directed to a system for populating a contact list on a portable device and recites:

means for extracting contact information from a number of messages stored in a memory in the portable device; and

means for entering the extracted contact information into a contact list maintained by a program operating on the portable device.

Neither Hara, Haynes nor Creswell, alone or in combination, disclose or suggest a method or system wherein contact information is extracted from a number of messages stored in a memory in a portable device and the extracted contact information is stored in a contact list maintained by a program operating on the portable device. In contrast, Hara merely discloses an e-mail addressing scheme which uses addresses contained in stored e-

Atty. Dkt. No. 051373-0115

mail messages to address outgoing e-mail messages. As acknowledged by the Office Action, Hara fails to disclose any storing of extracted e-mail addresses.

Haynes merely discloses a method and system wherein, as each e-mail comes in, address information is extracted and stored. Haynes does not disclose extracting contact information from messages stored in a memory.

Creswell merely discloses a system and method were in as each e-mail comes in or goes out, address information is stored. Like Haynes, Creswell does not disclose extracting contact information from messages stored in a memory. Moreover, in contrast to assertions made in the Office Action, Creswell does not disclose storing or entering extracted address information to a memory on the portable device. As previously noted in the response filed on August 22, 2005, Creswell stores address information in a directory 30 coupled to a network. Figure 1 of Creswell clearly illustrates directory 30 distinct from the user devices.

In apparent recognition of the deficiencies of Hara, Haynes and Creswell, the Office Action attempts to pick and choose selected features from each to achieve the method and systems recited in claims 1, 12, 16 and 21. However, neither Hara, Haynes nor Creswell provide any motivation for such a selective combination. In fact, Hara specifically teaches away from such a combination with Haynes or Creswell. Haynes and Creswell both teach extracting and storing information from incoming or outgoing e-mails in an address book. However, the whole purpose of Hara is to eliminate the need for storing addresses in an address book. Hara specifically states:

As a result, the user is no longer required to retrieve the address notebook so as to designate the transmission destination address as in the conventional electronic mail transmitting/receiving apparatus. Therefore, the operations and the operation time required to transmit the electronic mail can be considerably reduced.

See, Hara, col. 3, lines 23-28. Hara also states:

Moreover, as to users of electronic mails, they can intuitively retrieve their desired mail address in accordance with the mail address managing (retrieving) manner of the present invention

Atty. Dkt. No. 051373-0115

with using the key word, as compared with the mail address managing (relevant divisions) with using the address notebook of the conventional electronic mail transmitting/receiving method. As a consequence, the time and workload required to accomplish the transmission (mail address) of the electronic mail can be shortened.

See, Hara, col. 3, lines 42-50.

Thus, one of ordinary skill in the art following the teachings of Hara would clearly not modify Hara to additionally store extracted address information. As apparent from the teachings of Hara, the hypothetical modification of Hara proposed by the Office Action would instead destroy the intended functioning and mode of operation of Hara. The hypothetical modification proposed by the Office Action would result in the maintenance of an address book and consultation of the address book when addressing outgoing e-mails rather than eliminating or reducing the need for an address book by alternatively using stored messages when addressing outgoing e-mails as taught by Hara.

As noted in MPEP 2143.01, THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE and THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE. The hypothetical modification proposed by the Office Action does both and is thus improper. Moreover, since the hypothetical modification of Hara appears to be based upon the use of Applicant's own disclosure as a blueprint, the combination is improper. Accordingly, a rejection of claims 1, 12, 16 and 21 should be withdrawn.

In addition, even if Hara, Haynes and Creswell could be properly combined, the combination of Hara, Haynes and Creswell does not disclose, teach or suggest extracting information from messages stored in a memory in the portable device or a contact list maintained by a program operating on the portable device. In the Office Action the Examiner states: "Both Hara and Haynes are silent as to if their devices . . . are portable devices. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara in view of Haynes as evidenced by Creswell." See, Office Action, page 4. However,

Atty. Dkt. No. 051373-0115

Creswell does not teach populating a contact list on a portable device as asserted by the Examiner. Rather, Creswell teaches an automatic change server 26 coupled to a message server 20 and a network 12. See, Creswell, Figure 1, col. 3, lines 40-44. A user may use a device such as a wireless handset 15 to send messages to network 12. See, col. 3, lines 27-32. User address book 30, message server 20 and message store 22 communicates with the handset 15 via the network 12. See, Figure 1. Correct address information is used to update a user address book in a directory 30 coupled to the network. See, col. 3, lines 48-50. Accordingly, claims 1, 12, 16 and 21 are believed to be allowable.

Claims 2, 4-8 and 11 depend from independent claim 1 and incorporate all of the limitations of independent claim 1 and are therefore allowable over Hara in view of Haynes and Creswell for, among other reasons, the same reasons as given above with respect to independent claim 1. Claims 13 and 15 depend from independent claim 12 and incorporate all of the limitations of independent claim 12 and are therefore allowable over Hara in view of Haynes and Creswell for, among other reasons, the same reasons as given above with respect to independent claim 12. Claims 17-20 depend from independent claim 16 and incorporate all of the limitations of independent claim 16 and are therefore allowable over Hara in view of Haynes and Creswell for, among other reasons, the same reasons as given above with respect to independent claim 16.

Accordingly, claims 1-2, 4-8, 11-13 and 15-21 are believed to be allowable. Withdrawal of the rejection under 35 U.S.C. § 103 and allowance of claims 1-2, 4-8, 11-13 and 15-21 is respectfully requested.

B. Claims 5 and 6

Claim 5, depends from claim 1 and, as amended, recites that only messages sent or received before a preselected time, after a preselected time or during a time period are scanned. Claimed 6 depends from claim 5 and, as amended, for the recites that only messages sent or received after a time of a last scan are scanned.

Neither Hara, Haynes nor Creswell, alone or in combination, disclose scanning selected e-mails based upon the time that the e-mails or messages were sent or received and

Atty. Dkt. No. 051373-0115

extracting address information from the selected group of scanned e-mails. Accordingly, claims 5 and 6 overcome the rejection of this additional reason.

IV. Rejection of Claims 3, 9, 10 and 14 under 35 USC 103(a) Based upon Hara, Haynes, Creswell and Checkoway

Claims 3, 9, 10 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara in view of Haynes and Creswell and in further view of Checkoway et al. ("Checkoway," US Publication 2002/0133554). Applicants respectfully traverse the rejection. Claims 3, 9 and 10 depend from independent claim 1 and incorporate all of the limitations of independent claim 1 and are therefore allowable over Hara in view of Haynes, Creswell and Checkoway for, among other reasons, the same reasons as given above with respect to independent claim 1. Claim 14 depends from independent claim 12 and incorporates all of the limitations of independent claim 12 and is therefore allowable over Hara in view of Haynes, Creswell and Checkoway for, among other reasons, the same reasons as given above with respect to independent claim 12.

Accordingly, claims 3, 9, 10 and 14 are believed to be allowable. Withdrawal of the rejection under 35 U.S.C. § 103 and allowance of claim 3, 9, 10 and 14 is respectfully requested.

V. Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment.

Atty. Dkt. No. 051373-0115

to Deposit Account No. 50-3815. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-3815. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-3815.

Respectfully submitted,

Date May 10, 2006By Todd A. Rathe

RATHE PATENT & IP LAW
Customer Number: 59555
Telephone: (262) 478-9353
Facsimile: (262) 238-1469

Todd A. Rathe
Attorney for Applicant
Registration No. 38,276